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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,544	09/28/2001	Gan-Moog Chow	N.C. 82,637	3267

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EXAMINER

SAVAGE, JASON L

ART UNIT PAPER NUMBER

1775

DATE MAILED: 02/07/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

AS8

Advisory Action

Application No.

09/964,544

Applicant(s)

CHOW ET AL.

Examiner

Jason L. Savage

Art Unit

1775

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 December 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

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PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 19-25.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

JOHN J. ZIMMERMAN
PRIMARY EXAMINER

Continuation of 5. does NOT place the application in condition for allowance because: Applicant has not overcome the rejections to the claims. More specifically, Applicant's amendment to claim 23 does not overcome the rejection under 35 USC 112 first paragraph since claim 20 recites that the thin film contain an oxide [emphasis added] while claim 23 contains a conflicting limitation that the thin film may be a metal-metal [emphasis added]. How can the thin film be a metal-metal and also contain an oxide simultaneously? Applicant has also not overcome the rejection to claims 19-25 under 35 USC 103(a).

Applicant argues that Glumac does not disclose any specific particle size of n-materials and that a nanometer particle size can be a particle of a size ranging from a fraction of a nanometer to 1000 nanometers. Thus, applicant believes that Glumac does not actually teach the presently claimed subject matter. However, Applicant's argument appears to affirm the Examiner's rejection. Applicant readily admits that the teaching of Glumac encompasses a wide range of particle sizes which may be any size from 1 nm to 2000 nm, thus obviating the claimed subject matter. Absent a teaching of the criticality of the claimed particle sizes, it does not provide a patentable distinction over the prior art.

Applicant further argues that Glumac does not teach the limitation of claim 22 that the layers are integrated by graded interfaces rather than abrupt interfaces. As was clearly set forth in the rejection, Glumac teaches that the nanophase coating may be multicomponent, multiphase, compositionally modulated, or continuously graded structures (col. 5, ln. 28-39) which appears to meet the claim limitations. Applicant has failed to demonstrate how or why he feels that this teaching of Glumac does not meet the claim limitations, therefore the rejection has been maintained.

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JOHN J. ZIMMERMAN
PRIMARY EXAMINER